

Richard I. M. JEFFERY, *et al.*
Serial No. 10/555,276
December 1, 2008

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested.

The last office action was designated “final” based upon the allegation that “applicants’ amendment necessitated the new ground(s) of rejection...” However, the amendment last made (April 11, 2008) did not add any substantive limitations to the claims. The claims already required the data providers to perform the relevant steps enumerated in independent claims 1 and 10. Inherently, this already required those steps to be performed without requiring the client to install or execute additional software at the client. The only amendment made to claims in the earlier submission was to state the inherent requirement of the earlier claims. This did not necessitate any new search or present any new issues or the like that would have necessitated new grounds of rejection.

This same aspect of the originally claimed invention is also discussed as a fundamental advantage of the invention in the original specification (e.g., see the first paragraph of the summary section at page 5). Only because the Examiner appeared to overlook this requirement of the original claims was any amendment previously made.

Accordingly, the Examiner is respectfully requested to remove the “final” designation from the last office action.

Richard I. M. JEFFERY, *et al.*
Serial No. 10/555,276
December 1, 2008

The rejection of claims 10-18 under 35 U.S.C. §112, 2nd paragraph, is respectfully traversed.

Initially, it is noted that there may be a typographical error in this section of the office action since it appears from the Examiner's comments that the Examiner may have intended to reject all claims 1-18 on this ground. If so, such is also respectfully traversed.

Contrary to the Examiner's allegations, the phrase "capable of" does not in any way render the claimed subject matter indefinite. It is very clear that the limitations following the phrase are part of the claimed invention. If, at some relevant time, a data provider has access to a particular data item and is offering it to an end user, then such data provider is "capable of" providing that data item to an end user. If such is not the case, then the data provider is not "capable of" providing that data item to an end user. There is no indefiniteness at all in determining at any given time whether or not a provider is then "capable of" rendering the requested data item or not. It is, in fact, a binary determination that those skilled in the art will have no trouble understanding.

Furthermore, contrary to the Examiner's assertion, MPEP §2173.05(d) does not support this ground of rejection.

First of all, MPEP §2173.05(d) does not even mention the phrase "capable of." Secondly, this section of the MPEP refers to phrases "for example" or "such as" which

Richard I. M. JEFFERY, *et al.*
Serial No. 10/555,276
December 1, 2008

may indeed lead to confusion over the intended scope of a claim. However, even here, the prohibition is not absolute, but instead only inviting a rejection in those instances where it is not clear whether the claimed narrower range is a limitation. MPEP §2173.05(d) explicitly gives four examples where, in certain circumstances, the language “for example” or “such as” was held to be indefinite. The MPEP also specifically cautions the Examiner that such are mere examples that have been held to be indefinite in certain fact-specific circumstances and that such should not be applied as a “*per se*” rule.

In the current circumstance, the phrase “capable of” appearing in certain of applicants’ claims has a clear and definite meaning that those skilled in the art will have no difficulty understanding or applying. There is no possible ambiguity.

The rejection of claims 1-3, 6-12 and 15-18 under 35 U.S.C. §102 as allegedly anticipated by Leighton ‘061 is respectfully traversed.

The Examiner’s arguments, which appear on pages 3-5 of the office action, are flawed because they confuse (a) interactions between the web content provider and the actual end-user with (b) interactions between the web content provider and the end-user's local name servers.

In trying to find a teaching in Leighton that corresponds to the requirements of claim 1, the Examiner sometimes regards Leighton's actual end-user as the entity

Richard I. M. JEFFERY, *et al.*
Serial No. 10/555,276
December 1, 2008

corresponding to the "client" in the independent claims – but sometimes treats the end-user's local name server as the "client" instead. Unless the Examiner's argumentation can be consistent in this regard (i.e., using one or the other of these entities as the entity corresponding to the "client" in applicants' claims), the argument that the claims are anticipated is fundamentally flawed. The Examiner has been unable to do this because Leighton's actual end-user and the end-user's local name server are different entities, which perform different functions and are involved in different interactions. Applicants' claims are specific in explicitly requiring that it is the client that is involved in the various interactions with the system and with the data providers.

The above fundamental flaw in the Examiner's argumentation stems not just from failing to appreciate a minor technical difference. It appears that the Examiner has failed to appreciate a fundamental difference between the claimed invention and prior art of this type. Leighton's system and process are based entirely on identifying and measuring round-trip times (RTTs) on "proxy" or "core points" or "DNS" servers/hosts or "Local Server Names." However, the presently claimed invention requires the "measure of the elapsed time" to be obtained directly from the time between the sending of a test signal to the client and the receipt of the return signal from the client.

Richard I. M. JEFFERY, *et al.*
Serial No. 10/555,276
December 1, 2008

technique was to be implemented in respect of a few (possibly pre-registered) end-users, the measurements made would not be as accurate (for the purpose measurements are made by the system of the present invention) as those made by the system of the present invention, because the round-trip times measured in Leighton do not relate directly to interactions with the end-user's machine, but only to interactions with neighboring nodes or routers.

Another more practical reason as to why Leighton's technique would be an impractical way of obtaining the type of information upon which the system according to the present invention bases its decision (i.e., the selection of a "preferred data provider") is that the core points to which Leighton's system sends Internet Control Messaging Protocol (ICMP) or "PING" packets are generally managed by Internet Service Providers (ISPs), which normally reject ICMP packets in order to prevent Denial of Service (DoS) attacks to their network nodes or routers, thus interfering with or preventing the making of such measurements.

Another drawback of Leighton's technique is the fact that it is necessary to maintain a network map with "best servers" which is updated every 30 seconds and which is uploaded to the "core points." This adds to traffic overhead, "core point"

Richard I. M. JEFFERY, *et al.*
Serial No. 10/555,276
December 1, 2008

process overhead and network complexity, and means that remote or physical access is required to upload the "network maps."

In comparison, systems according to the present invention may have much lower "overhead" demands in relation to the corresponding requirements, and may perform measurements in "real-time" that relate directly and specifically to end-users' machines. There is no need to maintain "network maps," no need to access nodes that do not belong to the "data providers," and no need for extra software to be installed on individual end-users' machines.

Given such fundamental deficiencies of Leighton with respect to independent claims 1 and 10, it is not believed necessary at this time to explain further deficiencies of Leighton with respect to other aspects of the rejected claims. Suffice it to note that, as a matter of law, it is impossible for any reference to anticipate a claim unless it teaches each and every feature of that claim.

The rejection of claims 4-6 and 13-14 under 35 U.S.C. §103 as allegedly being made "obvious" based on Leighton in view of Yahagi '978 is also respectfully traversed.

Richard I. M. JEFFERY, *et al.*
Serial No. 10/555,276
December 1, 2008

Fundamental deficiencies of Leighton have already been noted above with respect to the parent claims. Yahagi does not supply those deficiencies. Furthermore, Yahagi, like Leighton, is incompatible with and actually teaches away from the applicants' claimed invention, even if considered *arguendo* in combination.

Regarding Yahagi, it is clear that a "Client" or "Plug-in" or "Controller" program is required to be installed on end-users' machines in order to send the signals to the servers/networks and retrieve the relevant responses. As explained before, with embodiments of the present invention, no such controller is needed, and the signal is initiated from the data provider to the end-user, so the response is processed on the "Server or Host side" rather than on the end-user's machine.


Given such fundamental deficiencies as have already been noted for these references, it is not believed necessary at this time to explain further deficiencies of these references with respect to other aspects of the rejected claims. Suffice it to note that, as a matter of law, it is impossible for a combination of references to support even a *prima facie* case of obviousness unless the alleged combination actually teaches or suggests each and every feature of the rejected claims.

Richard I. M. JEFFERY, *et al.*
Serial No. 10/555,276
December 1, 2008

Accordingly, this entire application is now believed to be in allowable condition,
and a formal notice to that effect is earnestly solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 
Larry S. Nixon
Reg. No. 25,640

LSN:lef

901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100